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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/815,642	04/02/2004	Kia Silverbrook	HYC007US	9566
24011	7590	09/02/2010		
SILVERBROOK RESEARCH PTY LTD 393 DARLING STREET BALMAIN, 2041 AUSTRALIA			EXAMINER UBER, NATHAN C	
			ART UNIT 3622	PAPER NUMBER
			NOTIFICATION DATE 09/02/2010	DELIVERY MODE ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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### Office Action Summary

**Application No.**

10/815,642

**Applicant(s)**

SILVERBROOK ET AL.

**Examiner**

NATHAN C. UBER

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 27 April 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1, 2, 10, 12 and 29 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 10, 12 and 29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### **Status of Claims**

1. This action is in reply to the RCE filed on 27 April 2010.
2. Claims 1, 10, 12 and 29 are amended.
3. Claim 3 is canceled.
4. Claims 1, 2 10, 12 and 29 are currently pending and have been examined.

### **Continued Examination Under 37 CFR 1.114**

5. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 17 March 2010 has been entered.

### **Claim Rejections - 35 USC § 112**

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:  
  
The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.
7. Claim 1 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention. Claim 1 newly claims "sending the serial number of the coupon to the administration server" however; there is no support for this limitation in the original disclosure. By adding this limitation now, Applicant introduces subject matter into the claims that was not part of the original disclosure.

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Therefore the newly added limitation in amended claim 1 is considered impermissible new matter and must be removed from the claim.

**Claim Rejections - 35 USC § 103**

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

10. Claims 1, 2, 10, 12 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Murphy et al. (4,554,446) in view of Lazzouni et al. (U.S. 5,661,506) and in view of Dymetman et al. (U.S. 6,330,976 B1).

**Claims 1, 2 and 29:**

Murphy discloses an inventory control method that uses a combination of machine readable and human readable indicia on product labels and coupons to track inventory, manage pricing, and conduct various incentive promotions electronically using a combination of point of sale machines and computers. (See at least Figures 1 and 2, see also column 4, lines 27-32). Product identification is discussed with reference to the UPC code (see at least column 3, lines 60-66), however Murphy also more broadly discloses bar codes which may be used to identify more than just UPC data and anticipates or at

least renders obvious Applicant's added limitation of *uniquely* identifying the "product item." Murphy particularly notes several different types of coupons including coupons disposed on the product itself as well as coupons that require the customer to transmit customer identification data to the product manufacturer. Murphy points out that in situations where coupons require interaction from the customer, many customers cannot be bothered (a sentiment echoed in applicant's specification), so Murphy solved this problem by creating coded forms and ID cards so that the customer can simply transmit requisite personal information electronically by swiping or entering their coded information. The coupon redemption methods are discussed broadly in columns 9 and 10. Lines 9/18-29, 9/48-61 and 10/22-46 are particularly relevant to applicant's claims directed towards transmission of coupon and customer information as well as submitting electronic forms. The Murphy disclosure explains that coupon fulfillment information is stored by the system, so that when a coupon is recognized by the system, the system can verify whether the stored coupon conditions are met before issuing the benefit (see at least column 10, lines 52-63 and column 11, lines 46-52). With regard to verifying a purchase by accessing a database, Murphy also discloses a verification procedure that relies on stored data to handle lost or destroyed documents. The Murphy system only records sales and voucher redemptions at the time of purchase and redemption. Therefore, if a customer claims later to have lost a voucher, the system can enter a replacement voucher for the customer. The system will quickly verify that the voucher was not already redeemed by accessing the stored information at the host computer (see at least columns 11-12, lines 64-67 and 1-2). Murphy also discloses a 'scan coupon concentrator' which is a data storage device that stores all of the compliance requirements for a given coupon/voucher, such compliance information often includes a verification of purchase of a particular item (see at least column 10, lines 52-63). Murphy also discloses storing purchase data and redemption data (see at least column 8, lines 1-7).

Further with respect to the limitations of claim 1 directed to sensing machine readable code, position data and redemption information, Murphy discloses at least two sensing steps (swipe and scan) as well as receiving and transmitting redemption information as previously discussed. Further the barcode scanning of Murphy inherently requires the generation of position data as this is the basis for successful bar code scanning. The sensing device must identify the position of the registration posts on the bar code before it can interpret the code residing between the posts. Additionally the position of the bar code itself is inherently valuable to the sensing and data gathering step, especially for products or barcode sheets that may have multiple bar codes. However, Murphy does not specifically disclose the narrower interpretation of *interaction data* as may be gleaned from the specification. Lazzouni, in at least column 4, lines 16-17, 25-26, 34-38, 46-50, 57-59 and in Figure 1 discloses generating interaction data based on sensing the position of a scanning device on substrate that is coded with infrared machine readable coordinate code. Similarly Dymetman, in at least column 8, lines 14-23 a physical page and a digital page isomorphism, wherein the position and information on the physical page may have meaning and be recorded or transmitted as claimed (see also column 14, lines 16-31, discussing a range of position and other data that can be encoded onto the physical page to reading by the pointer/scanner device). It would have been obvious to one having ordinary skill in the art at the time of the invention to enhance the Murphy invention by integrating additional coded data into printed labels and coupons as taught by Lazzouni and Dymetman since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

**Claims 10 and 12:**

Murphy does not disclose the limitations of claims 10 and 12. However, Lazzouni in at least in at least column 4, lines 16-17, 25-26, 34-38, 46-50, 57-59 and in Figure 1

discloses generating interaction data based on sensing the position of a scanning device on coded substrate. The *interaction data* includes a digital representation of writing (see at least Figure 1) and movement data (see at least column 4, lines 46-50).

**Claims 10, 12 and 29:**

With respect to the limitation of claims 10, 12 and 29, *the coded data further comprises position data identifying a position of the sensing device relative to the coupon*, the cited combination Murphy/Lazzouni discloses this limitation as shown above. The Lazzouni reference discloses a coded surface that is capable of generating interaction data representative of the position of the sensing device relative to the coded surface. Murphy discloses placing coupons on surfaces and using codes printed on surfaces to represent coupons. The combination of the references embraces identifying the location of the sensing device relative to anything printed on the coded surface.

**Response to Arguments**

11. Applicant's arguments filed 17 March 2010 have been fully considered but they are not persuasive. In Applicant's remarks Applicant argues that the combination of the Murphy and Lazzouni references are insufficient to disclose and render obvious the claimed invention because Murphy only teaches bar-code technology and Lazzouni only teaches using coded sheets to identify position data. Applicant alleges that the prior art technology would need to be further modified to meet the claimed subject matter and that "such (modification) is not as trivial as the examiner seems to indicate" (see page 4 of Applicant's remarks). Examiner reminds Applicant that the combination of references in the rejection above establishes a *prima facie* showing of obviousness; meaning that based on the level of ordinary skill in the art as demonstrated by the prior art references, and the combination of teachings from the prior art references, the claimed subject matter would have been obvious to such a skilled artisan. Whether or not technology or technology development is trivial is outside of the consideration of patentability. Examiner assures Applicant that no part of the rejection above offers any argument

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or evidence that any aspect of Applicant's invention is trivial. Further insofar as Applicant alleges that at the time of the invention it would not have been obvious to combine the teachings from the prior art of record (Examiner notes that Applicant did not support such an argument with evidence from the record or other evidence such as an affidavit or declaration) Examiner added a third reference which teaches a combination of position and coded data on a printed sheet having the same functionalities and properties as presently claimed by Applicant. This third reference both supports the previous rejection of the claims and offers further evidence of the state of the art before the priority date of Applicants' claimed invention. Accordingly, Applicant's arguments suggesting that combining coded data and position data is novel and non-obvious were not persuasive.



**Conclusion**

12. Any inquiry of a general nature or relating to the status of this application or concerning this communication or earlier communications from the Examiner should be directed to **Nathan C Uber** whose telephone number is **571.270.3923**. The Examiner can normally be reached on Monday-Friday, 8:30am-4:00pm EST. If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, **Eric Stamber** can be reached at **571.272.6724**.
13. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://portal.uspto.gov/external/portal/pair> <<http://pair-direct.uspto.gov>>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at **866.217.9197** (toll-free).
14. Any response to this action should be mailed to:

**Commissioner of Patents and Trademarks**

**P.O. Box 1450, Alexandria, VA 22313-1450**

or faxed to **571-273-8300**.

15. Hand delivered responses should be brought to the **United States Patent and Trademark Office Customer Service Window**:

Randolph Building  
401 Dulany Street  
Alexandria, VA 22314.

/Nathan C Uber/ Examiner, Art Unit 3622  
28 August 2010

/Arthur Duran/  
Primary Examiner, Art Unit 3622